

§Appl. No.: 09/901,632  
Amdt. Dated: March 3, 2004  
Reply to Office Action of: December 3, 2003

### **REMARKS**

Claims 13-17 and 20-30 remain in this application, claims 18 and 19 having been cancelled without prejudice or disclaimer. In the claims now pending before the Examiner, claims 13-17, 20 and 22 are directed to a unitary valve structure, while claims 23-29 are directed to a valve and support structure for a filter element. Claim 30 is an independent claim suggested by the Examiner as being patentable over the prior art but now rejected in view of new prior art.

### **Claim Objections and Rejections Under 35 U.S.C. §112:**

Applicant thanks the Examiner for the suggestions as to how the claims may be made definite by properly describing the invention, by providing proper antecedent basis for all recitations in the claims, by having proper claim dependency and by removing redundancies. The claims as amended include corrections to remove the indefiniteness identified by the Examiner.

All of the amendments to the claims are made to improve the form of the claims so that the claims properly define the invention by confirming to what is disclosed in the application. Specifically with respect to independent claims 13, 23 and 30, claims 13, 23 and 30 have been amended to recite that the spaced projections are upstream of the "sealing portion" of the collar. The claims as initially presented recited that the spaced projections were upstream of the "bypass valve." This is incorrect because the space projections are on the "bypass valve" and therefore can not be upstream of the bypass valve. It is respectfully submitted that this clarifying amendment raises no new issues and should be considered by the Examiner without the Applicant having to file a continuing application.

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**Rejections Under 35 U.S.C. §102:**

Claims 13, 14, 20, 22, 24 and 28 have been finally rejected under 35 U.S.C. §102(e) as anticipated by Suzuki et al. '183. Applicant respectfully traverses this rejection.

As was stated in the September 23, 2003 reply, in order for a rejection to be sustainable under 35 U.S.C. §102 it is necessary that the single applied reference teach every element of the claimed invention. This is not the case with Suzuki '183 because Suzuki does not teach projections between a sealing portion (the lip 33 of Applicant) and the filter element (Applicant's filter element 12) so that fluid pressure caused by clogging of the filter element subjects the sealing portion to an over pressure allowing the fluid to pass between the sealing portion and the filter element. In Suzuki et al. '183 the pressure is applied through openings in a portion of the filter element, i.e., the inner support 32, in order to apply pressure to the sealing lip 42, rather than being applied upstream through gaps between the filter element (which includes the portion 32) and the collar. Accordingly, Suzuki '183 does not anticipate these claims or any of the other claims now in this application, which claims all include projections upstream of the sealing portion between the filter element and the collar.

Claims 13-17 and 22-27 have been rejected under 35 U.S.C. §102(b) as being anticipated by Palmai '144. Applicant respectfully traverses this rejection.

Palmai '144 does not disclose projections between the filter element and valve. Rather, the projections identified by the Examiner as ribs 27 and 28 are within the valve itself because the projections extend between the bypass element 26 and the axial extension 33. Accordingly, Applicant's two independent claims 13 and 23 as well as the claims which depend therefrom are not anticipated by Palmai '144.

Claims 13-14, 20, 22, 24 and 28 have been rejected under 35 U.S.C. §102(b) as anticipated by Buckman '023. Applicant respectfully traverses this rejection.

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Buckman '023 does not disclose upstream spaced projections between the collar member of the valve and the filter element which engage both the collar member and the filter member in order to allow fluid pressure to be applied to the sealing portion of the collar member so as to effect separation of the sealing portion from the filter element. Rather, in Buckman '023 there are channels between castellations 34 which allow fluid pressure to pass through the inner support tube 30 in order to apply pressure to the neck 24 of the seal or valve member 20. Clearly, Buckman '023 functions in the same manner as Suzuki '183 in which fluid pressure is applied through the openings 35 of support tube 32 that is integral with the filter element 30. In neither case are there spaced projections upstream of a sealing portion such as Applicant's which allow fluid pressure to be applied to the sealing portion or lip. Note that the tapered notches of Buckman '023 are downstream of the sealing portion of the valve or seal 20. For these reasons, Buckman '023 does not anticipate Applicant's claims 14-19 or Applicant's new claims 23-30.

Claims 13-17 and 22-30 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Suzuki et al. '183 in view of Covington '199. Applicant respectfully traverses this rejection.

It is respectfully submitted that Covington '199 does not cure the deficiencies of Suzuki et al. '183 as a reference against Applicants' claims. Applicants claim:

"a collar having a sealing portion for sealing with the filter element and spaced projections upstream of the sealing portion."

As previously explained, in Suzuki et al. '183 there are no spaced projections upstream of the sealing portion 42. Covington '199 discloses different arrangement in which ribs 134 simply serve to stiffen the collar portion 120 (see col. 6, lines 20-22). There is no disclosure that the ribs 134 engage both the bypass valve portion and the filter element and no disclosure that the ribs are upstream of the sealing portion 130 which covers the

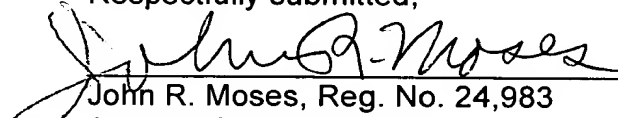
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opening 58. This is because in Covington '199 the ribs 134 are on the outside of the sealing surface of the sealing portion 130. In Covington '199 oil flows in the gap 53 (see Figs. 8 and 9) to the holes 58 in the outer sleeve of the support 112. If the projections, i.e., the ribs 144 are on the outside of the collar 110 and the oil is flowing inside the collar, the oil reaches the ribs 134 only after passing the sealing surface of the sealing portion 130. Therefore the ribs 134 of Covington '199 are downstream rather than upstream of the sealing surface of sealing portion 130. Clearly there is no teaching in Covington et al. '199 which cures the deficiencies of Suzuki et al. '183 as a reference against Applicant's claims because Covington '199 teaches away from Applicants claimed invention by placing projections downstream rather than upstream of the sealing surface.

In view of the above remarks, favorable reconsideration is courteously requested. If there are any remaining issues which could be expedited by a telephone conference, the Examiner is courteously invited to telephone counsel at the number indicated below.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

  
John R. Moses, Reg. No. 24,983  
Attorney for Applicant(s)

MILLEN, WHITE, ZELANO  
& BRANIGAN, P.C.  
Arlington Courthouse Plaza 1, Suite 1400  
2200 Clarendon Boulevard  
Arlington, Virginia 22201  
Telephone: (703) 243-6333  
Facsimile: (703) 243-6410  
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